

**REMARKS**

Applicant has carefully reviewed the Office Action mailed September 16, 2004. With this Response, Applicant has amended claim 5 and canceled claims 1-4 and 29-33. Claims 5-27 are currently pending in this application. It is noted that Applicant has amended and/or cancelled the above-identified claims solely to advance prosecution of the instant application and to obtain allowance on allowable claims at the earliest possible date. Accordingly, no admission may be inferred from the amendments of claims herein. Applicant expressly reserves the right to pursue the originally filed claims in the future.

In the office action, claim 5 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,298,717 to DeRossett. This rejection is overcome because DeRossett does not disclose the step of detecting the corner of a workpiece.

DeRossett discusses the etching of a vehicle VIN number on the windshield and side window of an automobile (column 8, lines 49-52). The emission end of a marking head 27 is placed adjacent the surface to be etched so that a pair of locator pins 68 are in contact with the surface to be etched. When the emitter housing 16 is properly positioned adjacent the surface 22 to be etched as determined by the locator pins 68, a vacuum system is automatically activated and the emission end of the marking head 27 is drawn securely against the surface being etched (column 8, lines 64-68). As shown in figure 5, a resilient hood 74 surrounds the marking head 27 (column 6, line 45). The hood 74 serves as a light seal when the emitter housing 16 is positioned for etching operations (column 6, lines 46-47). Importantly, DeRossett fails to disclose the step of detecting a corner of the surface to be etched. The fact that the edges of the side window of the automobile shown in figure 9 are disposed within the doorframe of the

automobile suggests that DeRossett does not contemplate the step of detecting a corner of that side window.

Claim 5 recites a method of imparting etched indicia to a planar workpiece. This method comprises the steps of detecting a corner of the planar workpiece and calculating an optimal indicia location proximate the corner of the workpiece according to established parameters. A laser beam etcher is moved adjacent to the optimal indicia location and indicia is imparted to the workpiece.

In the instant case, the ordinarily skilled artisan would not have been motivated to modify DeRossett to yield the method recited in claim 5 because DeRossett shows the emission end of a marking head 27 placed adjacent the side window of an automobile while the corners of the side window are disposed within the doorframe of the automobile. Additionally, DeRossett teaches that a resilient hood 74 surrounds the marking head 27 as the emission end of the marking head 27 is drawn securely against the surface being etched. As shown in figures 5 and 9 of Rossett, the hood 74 would collide with the doorframe of the automobile if an attempt was made to position the emission end of the marking head 27 proximate a corner of the side window.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. 2143.03. Because DeRossett does not teach all steps recited in amended claim 5, Applicant respectfully submits that this claim is now in condition for allowance. Claims 6-7 depend from claim 5 and recite additional limitations, Applicant respectfully submits that these dependent claims are also in condition for allowance.

Claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,298,717 to DeRossett. This rejection is overcome because DeRossett does not disclose the steps of finding a first edge of a planar workpiece and finding a second edge of a planar workpiece.

Applicant's claim 8 recites a method of determining a desired indicia location proximate a corner of a workpiece comprising the steps of finding a first edge of a planar workpiece, finding a second edge of the planar workpiece and determining first and second offset distances. The method further includes the step of positioning an etcher adjacent to an intersection of a first inset line and a second inset line and imparting indicia to the planar workpiece surface at the intersection.

DeRossett discusses the etching of a vehicle VIN number on the windshield and side window of an automobile (column 8, lines 49-52). The emission end of a marking head 27 is placed adjacent the surface to be etched so that a pair of locator pins 68 are in contact with the surface to be etched. Unlike the method recited in claim 8, DeRossett does not disclose the steps of finding a first edge and finding a second edge of the surface to be etched. Additionally, fact that the edges of the side window of the automobile shown in figure 9 are disposed within the doorframe of the automobile suggests that DeRossett does not contemplate the steps of finding a first edge and finding a second edge of that side window.

Under 35 U.S.C. 103(a), "[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." One difference between the method recited in claim 8 and DeRossett is the step of detecting the edge of a workpiece.

In the instant case, the ordinarily skilled artisan would not have been motivated to modify DeRossett to yield Applicant's claimed invention because DeRossett shows the emission end of a marking head 27 placed adjacent the side window of an automobile while the edges of the side window are disposed within the doorframe of the automobile. For this reason, Applicant

respectfully submits that independent claim 8 is now in condition for allowance. Claim 9 depends from claim 8 and recites additional limitations, Applicant respectfully submits that this dependent claim is also in condition for allowance.

Claim 10 was rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,298,717 to DeRossett. This rejection is overcome because DeRossett does not disclose the step of obtaining the dimensions of a workpiece as recited in Claim 10. Unlike DeRossett, Applicant's invention as recited in claim 10 is a method comprising the steps of obtaining the dimensions of a planar surface, inputting an approximate desired indicia location, and calculating an optimal indicia location on the planar surface according to the desired indicia location.

Under 35 U.S.C. 102(b), an applicant is entitled to a patent unless the invention was described in a printed publication more than one year prior to the applicant's filing date. In the present case, DeRossett fails to disclose the step of obtaining the dimensions of a planar surface. Because DeRossett does not teach every step of Applicant's claimed method, this reference does not anticipate Applicant's claimed method. Accordingly, Applicant respectfully submits that claim 10 is now in condition for allowance. Claims 11-13 depend from claim 10 and recite additional limitations; Applicant respectfully submits that these claims are also in condition for allowance.

Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,298,717 to DeRossett. Applicant's invention as recited in claim 14 is a method comprising the steps of providing a planar workpiece and determining a location proximate a corner of the planar workpiece where indicia will be imparted to the planar workpiece. The method also comprises the steps of detecting a first edge of a planar workpiece, detecting a second edge of the planar workpiece and determining first and second offset distances. An etcher is positioned

adjacent to an intersection of a first dimension and a second dimension and indicia is imparted to the planar workpiece surface at the intersection.

DeRossett discusses the etching of a vehicle VIN number on the windshield and side window of an automobile (column 8, lines 49-52). The emission end of a marking head 27 is placed adjacent the surface to be etched so that a pair of locator pins 68 are in contact with the surface to be etched. Importantly, DeRossett does not disclose the steps of detecting a first edge and detecting a second edge of the surface to be etched. Additionally, the fact that the edges of the side window of the automobile shown in figure 9 are disposed within the doorframe of the automobile suggests that DeRossett does not contemplate the steps of detecting a first edge and detecting a second edge of that side window.

Unlike DeRossett, Applicant's claim 14 recites a method of determining a desired indicia location proximate a corner of a workpiece comprising the steps of detecting a first edge of a planar workpiece and detecting a second edge of the planar workpiece. Under 35 U.S.C. 103(a), "[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." One difference between the method recited in claim 14 and DeRossett is the step of detecting the edges of a workpiece. In the instant case, the ordinarily skilled artisan would not have been motivated to modify DeRossett to yield Applicant's claimed invention because DeRossett shows the emission end of a marking head 27 placed adjacent the side window of an automobile while the edges of the side window are disposed within the doorframe of the automobile.

For the reasons discussed above, Applicant respectfully submits that independent claim 14 is now in condition for allowance. Claim 15 depends from claim 14 and recites additional limitations, Applicant respectfully submits that this dependent claim is also in condition for allowance.

Claim 16 was rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,298,717 to DeRossett. This rejection is now overcome because DeRossett does not disclose the step of testing a workpiece as recited in amended claim 16.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” M.P.E.P. 2143.03. Applicant’s invention as recited in amended claim 16 is a method comprising the steps of determining window specification data by testing a workpiece, transmitting the window specification data to an indicia imparter, and imparting indicia on a planar surface of the workpiece. Unlike Applicant’s claimed invention, DeRossett does not disclose the step of determining window specification data by testing a workpiece.

Because DeRossett does not teach every step of Applicant’s claimed method, this reference cannot render Applicant’s claimed method obvious. Accordingly, Applicant respectfully submits that claim 16 is now in condition for allowance. Claims 17-28 depend from claim 16 and recite additional limitations; Applicant respectfully submits that these claims are also in condition for allowance.

In light of the above discussion, Applicant respectfully submits that all of the claims are in condition for allowance and courteously requests prompt notice of the same. If a telephone conference would be of assistance, please contact the undersigned practitioner at 612/492-7000.

Respectfully submitted,



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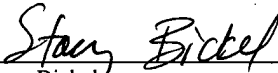
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